

confusion that may have been caused by improper headings, applicant has amended the specification at pages 4 and 7 to include headings suitable for the required parts.

The Examiner has also indicated that the application does not contain an abstract of the disclosure. Applicant respectfully submits that an abstract was provided in the originally filed application at page 14. A true and correct copy of the originally filed abstract is attached hereto on a separate page.

Claim Rejections Generally

The Examiner has indicated that claims 1 - 13 are pending in the application; that claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; that claims 1 - 11 are rejected under 35 U.S.C. 103(a) as unpatentable over Dunchock U.S. Pat. No. 5,845,369 and/or Bruno U.S. Pat. No. 4,969,239 in view of Wakefield U.S. Pat. No. 2,363,914; and that claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claims 1-11, and further in view of Krauthamer U.S. Pat. No. 3,178,784. Applicant, by this Amendment, cancels the rejected claims, and submits new claims 14-22, in accordance with the Examiner's indications.

Response to Rejections Based on 35 U.S.C. § 112

The Examiner has indicated that claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has cancelled claims 12-13 and has not rewritten them anew for submission at this time.

Response to Rejections Based on 35 U.S.C. § 103(a)

The Examiner has indicated that claims 1 - 11 are rejected under 35 U.S.C. 103(a) as

unpatentable over Dunchock U.S. Pat. No. 5,845,369 and/or Bruno U.S. Pat. No. 4,969,239 in view of Wakefield U.S. Pat. No. 2,363,914; and that claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the same references as applied to claims 1-11, and further in view of Krauthamer U.S. Pat. No. 3,178,784.

It should be noted that there is no suggestion or teaching in any of the references to modify or combine the disclosed devices to make a releasable eyeglass holder employing magnetic means to fasten the holder to a garment, and "although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, quoting *In re Dembiscak*, 175 F.3d 994, 999 (CAFC 1999).

Concerning prior art cited in the instant case, Wakefield teaches the use of magnets fixed in a cardboard base upon which to fasten paper clothing to a paper (cardboard) doll. The very notion of using magnets in Wakefield is to simplify dressing and undressing the doll, but the magnets are nonetheless conceived of as fixed and permanent. (See Col. 2, lines 19-26). Bruno teaches a ski goggle arm clip. This is a device that solves a different problem, and as much is admitted by Bruno (see Col. 1, lines 19-28). Thus, Bruno is not appropriately combined with Wakefield to make the present invention. The combination of Dunchock and Wakefield is equally inapt, again for the reason that Wakefield does not teach using the magnets as releasable elements. In each case there is no express teaching that the disclosure contained therein should be combined with any one or more of the other references, and the showing of combinability is thus not clear and particular.

Krauthamer has not been addressed in these remarks inasmuch as claims 12-13 have not been rewritten for submission in this amendment.

For the foregoing reasons, Applicant respectfully submits that the apparatus claims in newly submitted claims should be allowable over the cited references.



Regarding the Drawings

Applicant has submitted substitute informal drawings, filed herewith, to add reference numeral 29 with appropriate lead lines showing the bridge shown in original Figs. 1-3, and 12-13. Accordingly, this amendment to the drawings does not involve the insertion of new matter into the application.

Applicant has also added reference numerals 25 and 27 to show the holding area formed by the bridge 29 and foam 27 affixed to the interior surface of the holding area and partially filling the opening formed by bridge 29. These elements, too, were described at page 10, line 22, through page 11, line 2, and page 9., lines 12-16, and therefore their addition does not constitute the insertion of new matter into the application.

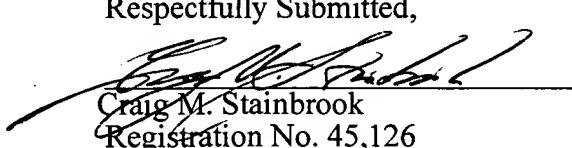
The Examiner has further indicated that the original (informal) drawings are objected to, and that new drawings are required. Applicant will file new, formal drawings upon receipt of the Notice of Allowability.

Conclusion

In view of these amendments and comments it is respectfully submitted that all pending claims are allowable, and such allowance is respectfully requested. The Examiner is invited to call Applicant's undersigned attorney if, in the opinion of the Examiner, a telephone conference will in any way expedite prosecution of this application.

Respectfully Submitted,

Date: 11 Apr. 2001


Craig M. Stainbrook
Registration No. 45,126
3550 Round Barn Blvd., Suite 203
Santa Rosa, CA 95403
Telephone (707) 578-9333